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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,552	08/28/2003	Carl F. Oresick	D/A2328	7596

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/650,552

Applicant(s)

ORESICK ET AL.

Examiner

Cong-Lac Huynh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/26/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

1. This action is responsive to communications: the application filed on 8/28/03, and the IDSs filed 8/26/03.
2. Claims 1-51 are pending in the case. Claims 1 and 26 are independent claims.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 11, 36, 21, 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Regarding claims 11 and 36, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
6. Regarding claims 21 and 46, it is unclear how the document is distributed to a recipient when the distribution job is not complete since if the distribution job is not complete, it means that the document is not distributed to a target yet.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-7, 16-24, 26-32, 41-49, 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Auglin, Jr. et al. (US Pat No 5,892,591, 4/6/99, filed 11/22/96).

Regarding independent claim 1, Auglin discloses:

(a) providing a document distribution job information in the cover sheet information, the document distribution job information including an originator information including the originator network address and, for each recipient, a recipient information including the recipient network address (figure 3, col 4, lines 48-67: the cover sheet includes the destination facsimile number for transmitting the document where the destination facsimile number is the recipient network address, and transmitting document is equivalent to distributing document)

(b) providing the document to an included document distributing apparatus (figures 2 and 3, col 4, lines 48-67: the originating facsimile is a document distributing apparatus for transmitting a document)

Regarding claim 2, which is dependent on claim 1, Auglin discloses sending the document to the document distributing by means of an included network (figures 2 and 3).

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Regarding claim 3, which is dependent on claim 2, Auglin discloses that the originator document sending performed by means of an included originator document communication device (figures 2 and 3).

Regarding claim 4, which is dependent on claim 1, Auglin discloses that the document distribution job information providing step (a) including providing a message information (abstract, col 4, lines 39-67).

Regarding claim 5, which is dependent on claim 1, Auglin discloses that the document distribution job information providing step (a) including providing a routing information (abstract, col 4, lines 39-67, col 5, lines 1-17, figure 3).

Regarding claim 6, which is dependent on claim 1, Auglin discloses, by the document distributing apparatus:

(c) receiving the document from the originator (col 4, lines 48-52: transmitting the document to the remote computer and the remote computer scans the cover sheet implies that the document is received from the originator, which is the original facsimile)

(d) scanning the document to provide the document distribution job information (col 4, lines 48-52)

(e) distributing the document by means of an included network to one or more recipient based on the job distribution information (figure 3, col 5, lines 1-30: transmitting the

document via the network computer to one or more recipients based on the information on the cover sheet)

Regarding claim 7, which is dependent on claim 1, Auglin discloses, by a recipient:

(f) receiving the document from the document distributing apparatus (figure 3: the document is received in the destination facsimile from the remote computer, which is equivalent to the document distribution apparatus)

(g) returning the document to the document distributing apparatus (col 5, lines 31-40)

Regarding claim 16, which is dependent on claim 7, Auglin discloses the recipient document receiving performed by means of an included corresponding recipient document communication device (figure 3).

Regarding claim 17, which is dependent on claim 16, Auglin discloses that the recipient document communication device comprises any of (i) a fax terminal and (ii) one or more devices arranged to provide functions of email, scan and print (figure 3: destination facsimile is the fax terminal, a document communication device).

Regarding claim 18, which is dependent on claim 7, Auglin discloses:

(h) receiving the document from the recipient (col 5, lines 18-21)

(i) determining when the document distribution job is complete (col 5, lines 31-36)

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Regarding claim 19, which is dependent on claim 18, Auglin discloses returning the document to the originator by the document distributing apparatus when it is determined the document distribution job is complete (col 5, lines 22-39).

Regarding claim 20, which is dependent on claim 19, Auglin discloses sending the document to the originator by means of the network (col 5, lines 31-39).

Regarding claim 21, which is dependent on claim 18, Auglin discloses distributing the document to one or more recipients based on the document distribution job information when it is determined that the document distribution job is not complete (col 6, lines 40-64, col 5, lines 22-30).

Regarding claim 22, which is dependent on claim 18, Auglin discloses that the network comprises a public telephone network (figure 3).

Regarding claim 23, which is dependent on claim 18, Auglin discloses that the network comprising an Internet (col 5, lines 31-39, col 6, lines 29-39).

Regarding claim 24, which is dependent on claim 18, Auglin discloses that the network comprising a wireless or radio frequency network (figure 3).

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Claims 26-32, and 41-49, 51 are for a document distributing apparatus for method claims 1-7, 16-24, and are rejected under the same rationale.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 8-15, 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auglin as applied to claim 1 above, and further in view of Braun et al. (US Pat App Pub No 2004/0061888, 4/1/04, filed 9/20/02).



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Regarding claims 8-11, which are dependent on claims 7-10 respectively, Auglin does not disclose, by the recipient, modifying the cover sheet information by marking the cover sheet with a marking instrument comprising any of a pencil, pen, crayon, or the like.

Braun discloses updating the facsimile cover sheet by a pen ([0007]).

It would have been obvious to an ordinary skill in the art at the time of the invention was made to combined Braun into Auglin for easily editing the cover sheet information using a pen, which is a marking tool without using a keyboard.

Regarding claim 12, which is dependent on claim 7, Auglin does not disclose modifying any of the cover sheet information and the document sheet information.

Braun discloses modifying any of the cover sheet information and the document sheet information ([0007]: updating the cover sheet shows modifying any of the cover sheet information and the document sheet information).

It would have been obvious to an ordinary skill in the art at the time of the invention was made to have combined Braun into Auglin for conveniently using a pen for modifying a facsimile as well as the facsimile cover sheet without the need of a keyboard of a computer.

Regarding claim 13, which is dependent on claim 12, Auglin does not disclose marking any of the cover sheet and the one or more document sheets.

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Braun discloses marking any of the cover sheet and the one or more document sheets ([0007]: updating the facsimile cover sheet by a pen implies that the cover sheet is marked by a pen some data).

It would have been obvious to an ordinary skill in the art at the time of the invention was made to have combined Braun into Auglin for easily editing the cover sheet information using a pen, which is a marking tool without using a keyboard.

Regarding claims 14 and 15, which are dependent on claims 13 and 14 respectively, Auglin does not disclose marking any of the cover sheet and the one or more document sheets by means of a marking instrument comprising any of a pencil, pen, crayon, or the like.

Braun discloses marking any of the cover sheet and the one or more document sheets by means of a marking instrument by means of a pen ([0007]: using a pen to update the cover sheet).

It would have been obvious to an ordinary skill in the art at the time of the invention was made to have combined Braun into Auglin for easily editing the cover sheet information using a pen, which is a marking tool without using a keyboard.

Claims 33-40 are for a document distributing apparatus for method claims 8-15, and are rejected under the same rationale.

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12. Claims 25 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Auglin in view of Braun as applied to claim 18 above, and further in view of Constantin et al. (US Pat App Pub No 2003/0002068, 1/2/03, filed 6/27/01).

Regarding claim 25, which is dependent on claim 18, Auglin does not disclose that the document comprising any of a purchase order, expense report and time card.

Constantin discloses distributing a document which can be a contract, purchase order, or article ([0039]).

It would have been obvious to an ordinary skill in the art at the time of the invention was made to have combined Constantin into Braun and Auglin since documents including a contract, purchase order and article for distributing as in Constantin would expand the scope of using different types of documents in distributing.

Claim 50 is for a document distributing apparatus for method claim 25, and is rejected under the same rationale.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Baran (US Pat No 5,247,591, 9/21/93).

Schmid et al. (US Pat No 5,659,164, 8/19/97).

Kanno et al. (US Pat No 6,493,115, 12/10/02).

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Reifman et al. (US Pat No 5,917,615, 6/29/99).

Melen et al. (US Pat No 6,263,121, 7/17/01).

Rouse (US Pat No 5,860,066, 1/12/99).

James et al. (US Pat No 6,742,161, 5/25/04).

Harris (US Pat No 6,799,717, 10/5/04).

Jeffrey et al. (US Pat App Pub No 2002/0083090, 6/27/02).

Kadowaki (US Pat App Pub No 2004/0057068, 3/25/04).

Barrus (US Pat App Pub No 2005/0162686, 7/28/05).

Ferlitsch (US Pat App Pub No 2005/0015428, 1/20/05).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh  
Primary Examiner  
Art Unit 2178  
03/13/06